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OFFICE OF PETITIONS

In re Application of
Luntz and Rose
Application No. 10/728,832
Filed: December 8, 2003
Attorney Docket No. 27056.2640

DECISION ON PETITIONS

This is in response to the petition under 37 CFR 1.137(b), filed June 9, 2006, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in the above-identified application.

On March 9, 2004, the Office mailed a Notice to File Missing Parts of Nonprovisional Application, indicating that the declaration did not identify the residence and the citizenship of each inventor, and was not signed by inventor Luntz. The Notice to File Missing Parts set a two-month extendable period to reply. On June 9, 2004, applicants filed a timely petition under 37 CFR 1.47(a), accompanied by a request for an extension of time within the first month (including a general authorization to charge fees), and a declaration identifying the residence and citizenship of joint inventor Rose. On June 23, 2004, the Office mailed a Notice of Incomplete Reply, stating that the reply of June 9, 2004, was incomplete because the declaration was missing the signature, residence, and citizenship of inventor Luntz, and that no surcharge for the late filing was received.

On June 30, 2004, applicants filed a second petition under 37 CFR 1.47(a), a request for an extension of time for response within the second month (including a general authorization to charge fees), and a declaration that identified the residence, mailing address, and citizenship of each inventor; however, the signature of inventor Luntz was missing. The petition was dismissed by the decision of July 13, 2004, which set a two-month extendable period for response. Furthermore, the decision indicated that the extension of time for response within the second month was unnecessary and the \$ 310.00 fee was refunded.

On July 23, 2004, applicants filed a renewed petition under 37 CFR 1.47(a), which was granted by the decision of May 19, 2006. Nevertheless, on May 18, 2006, the Office mailed a Notice of Abandonment for failure to respond to the Notice to File Missing Parts. On June 9, 2006, applicants filed the present petition. In the present petition, applicants assert that the application is not

abandoned and request that the Office withdraw the holding of abandonment. Specifically, applicants aver that they timely filed a petition under 37 CFR 1.47(a), which was subsequently granted on May 19, 2006.

Upon a review of the record, applicants' assertion is correct. Applicants filed a timely and proper response to the Notice to File Missing Parts on June 9, 2004. Specifically, the payment of the surcharge, accompanied by either a properly signed oath or declaration in compliance with 37 CFR 1.63 or the filing of a petition under 37 CFR 1.47(a) and an oath or declaration in compliance with 37 CFR 1.63 signed by the available inventors are both appropriate responses to the Notice to File Missing Parts. Therefore, the Office should not have mailed the Notice of Incomplete Reply of June 23, 2004, or the Notice of Abandonment of May 18, 2006.

In view of the above, the petition to withdraw the holding of abandonment is granted. The application will be restored to pending status. No petition fee is required.

The Office of Initial Patent Examination has been advised of this decision granting the petition to withdraw the holding of abandonment. This matter is being referred to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

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